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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,848	06/18/2001	Leona E. Ling	CIBT-P01-119	9957

28120 7590 05/06/2003

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EXAMINER

YAEN, CHRISTOPHER H

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 05/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/883,848

Applicant(s)

LING ET AL.

Examiner

Christopher H Yaen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-35 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Upon further review and reconsideration, the restriction requirement set forth in paper no. 13 is vacated in view of the following new restriction requirement.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-17, and 25-27 drawn to a method of promoting angiogenesis in a subject comprising administering an angiogenic amount of a hedgehog polypeptide or agonist thereof, classified in class 514, subclass 2.  
  
Furthermore, if applicant elects this group for prosecution on the merits, applicant is required to select ONE sequence (SEQ ID No: 1-20), ONE chemical moieties (polyalkylene glycol polymer, phosphate groups, acetyl groups, sugar or carbohydrate groups), ONE agent (VEGF, HGF, bFGF, angiopoietin-1, angiopoietin-2, or MCP-1), and ONE specific variable for each of Ar, Ar', Y, X, M, R, Cy, Cy', i, and n. This requirement should NOT be construed as a requirement for election of species (see below for explanation).
  - II. Claims 28-29, drawn to a method of promoting angiogenesis in a subject comprising administering an angiogenic amount of a hedgehog nucleic acid molecule, classified in class 536, subclass 23.1.
  - III. Claims 18-24 and 30-34, drawn to a method of inhibiting angiogenesis comprising the administration of an antiangiogenic amount of hedgehog antagonist, classified in class 514, subclass 2. Furthermore, if applicant

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elects this group, please select one of the following formulas: I-XI, wherein if the applicant elects formula I, applicant must select one specific R1, R2, L, X1, X2, Y1, Y2, Z1, Z2, R8, p, and n; wherein if applicant elects formula VI, applicant must select one specific R1, R2, R3, R4, L, X, D, Y, Z, E, R8, p, n, q, and r. This requirement should NOT be construed as a requirement for election of species (see below for explanation).

The inventions are distinct, each from the other because of the following reasons:

4. The inventions differ one from the other because the inventions are drawn to methodologically different procedures which require different reagents, different protocols and have different purposes and are used for different reasons.
5. Because these inventions are distinct for the reasons given above and the search required for Groups I-III are not required for one for the other, restriction for examination purposes as indicated is proper.
3. The inventions claim multiple factors (i.e. sequence, agents, formulas, variables) that render the claims distinct and separate inventions. Because the factors differ in structure function and chemical properties, the restriction requirement for proper examination must be made. This restriction requirement is deemed proper because the search for the different inventions would require undue search because multiple inventions are present that would be classified in different classes because of the different variables associated with the .
4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be

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traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher H Yaen whose telephone number is 703-305-3586. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on 703-308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Christopher Yaen  
Art Unit 1642  
May 5, 2003

  
ANTHONY C. CAPUTA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600